

I  
B7  
end

assembling the sequence of bus transactions into an object file representing bus stimuli;  
initializing the at least one bus agent; and  
executing the bus stimuli.

A  
end  
X  
S7  
B7

26. (Amended) The method of claim 25, wherein the defining act includes bus stimuli that when executed by the transaction generator, generates errors on the bus.

27. (Amended) The method of claim 25, wherein the defining act comprises defining processor-initiated bus transactions.

X  
S7  
B7

28. (Amended) The method of claim 25, wherein at least one processor is coupled to the bus, and wherein the defining act comprises defining native bus transactions that stimulate target agent bus transactions.

#### REMARKS

The Office action dated May 17, 1999, and the references cited therein have been carefully considered. Claims 1-28 are amended herein. In view of the amendments and the remarks presented herein, all pending claims overcome the rejections set forth in the Office action. Accordingly, favorable reconsideration of the application and allowance of claims 1-28 are respectfully requested.

The following remarks are numbered to reference the same numbered paragraphs of the Office action to which they are directed.

**Paragraph 2.** The title is amended herein.

HOBBS ET AL.  
Application No. 08/992,222

**Paragraph 3.** This paragraph is incomplete.

**Paragraph 4.** This paragraph is also incomplete as it fails to specify which claims are rejected under 35 U.S.C. § 102(b) under Pawlowski, U.S. Patent 5,696,910. Applicants believe the Office action meant to reject claims 1, 2, 4-8, 12, and 16-20, as reflected in paragraphs 5-12.

**Paragraph 5.** Claim 1 was apparently rejected as being anticipated by Pawlowski, col. 3, lines 1-5 and col. 1., lines 57-65.

The Office action fails to establish a *prima facie* case of anticipation as Pawlowski fails to teach all the recited claim limitations as required by the MPEP. In order to be anticipatory, a reference must teach each and every aspect of the claimed invention. MPEP § 706.02. The burden is on the Office Action to establish a *prima facie* case of anticipation, which has not been done. Furthermore, Pawlowski, alone or in combination with the other prior art references of record, neither teaches nor suggests the claimed invention.

In contrast to Pawlowski, the invention as recited in amended claim 1 is directed to a system for testing a bus. This bus testing system includes "at least one instruction memory to store a predefined bus stimuli instruction, the predefined bus stimuli instruction representing a native bus transaction," which is neither taught nor suggested by the prior art of record. Although many high-level and assembly language computer instructions may eventually result in a bus transaction, they do not have instructions representing native bus transactions, they do not provide an efficient mechanism to test a bus, nor do they allow the control of the exact sequence of bus cycles as provided for in the present invention which allows the bus to be tested better than previous systems.

For at least these reasons, independent claims 1 and its dependent claims 2-14 are believed to be allowable.

HOBBS ET AL.  
Application No. 08/992,222

**Paragraphs 6-9, 11.** Claim 2, 4-6 and 12 are believed to be allowable for at least the reasons for allowance of independent claim 1.

**Paragraph 10.** The Office action rejects claims 7 and 8 under 35 U.S.C. § 102(b) as being anticipated Pawlowski. Yet, the Office action takes Official Notice in rejecting claims 7 and 8, which, according to the MPEP, is an invalid § 102 rejection. Applicants request a proper rejection, and believe claims 7 and 8 are allowable for at least the reasons for allowance of independent claim 1.

**Paragraph 12.** Claims 16-20 were rejected for the same rationale as for claims 1-6. Applicants believe claims 16-20 are allowable for at least the same reasons as presented herein in relation to claims 1-6. Further, as claims 16-20 recite different elements than claims 1-6, applicants request allowance of a claim or the Office action to provide a rejection for each element/limitation and the recited combination for each claim as required by the MPEP.

**Paragraph 14, 16.** Claims 3, 9, 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pawlowski, U.S. Patent 5,6969,910, and further in view of Cloutier, U.S. Patent 5,892,962. Extracting from paragraphs 18, 19 and 21, the Office action apparently meant to reject claims 3, 9-11, 13-15, and 21-28 under 35 U.S.C. § 103(a).

The Office action fails to establish a *prima facie* case of obviousness as Pawlowski, alone or in combination with Cloutier, neither teaches nor suggests all the claim elements and limitations as required by the MPEP. The burden is on the Office Action to establish a *prima facie* case of obviousness, which has not been done as the MPEP requires, *inter alia*, that:

"the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

MPEP § 706.02(j) (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991))(emphasis added).

There is no teaching or motivation within Pawlowski and/or Cloutier to combine these references as done by the Office action; and even if so, the resulting system is not the claimed invention. The motivation for combining these references presented in the Office action is to improve the accuracy and flexibility of the storage involved and that both references deal with the same art in the field of computers. However, this rational does neither teaches nor suggests the claimed combination, rather suggests improvements can be made to the systems described in the references, but the references do not suggest what improvements to be made. Rather, the Office action apparently relies on applicant's disclosure for teaching the claimed combination which is prohibited by the MPEP.

Additional comments are numbered to reference the same numbered paragraphs of the Office action to which they are directed.

**Paragraphs 15, 17-19.** Claims 3, 9-11, 13, and 14 are allowable for at least the reasons presented for allowance of claim 1.

**Paragraph 20.** As per claim 15, the Office action fails to make a proper procedural obviousness rejection as it fails to comply with the requirements of MPEP § 706.02(j). Moreover, the Office action fails to establish a *prima facie* case of obviousness as Pawlowski, alone or in combination with Cloutier neither teaches nor suggests all the claim elements and limitations as required by the MPEP.

In contrast to Pawlowski and/or Cloutier, the invention as recited in amended claim 15 is directed to a system for testing a bus. This bus testing system includes "an instruction memory storing digital data representing a predefined sequence of native bus stimuli," which is neither taught nor suggested by the prior art of record. Although many high-level and assembly

HOBBS ET AL.  
Application No. 08/992,222

language computer instructions may eventually result in a bus transaction, they do not have instructions representing native bus transactions, they do not provide an efficient mechanism to test a bus, nor do they allow the control of the exact sequence of bus cycles as provided for in the present invention which allows the bus to be tested better than previous systems.

**Paragraph 21.** Method claims 21-28 are rejected as referenced and applied to apparatus claims 1, 15, and 16. Claims 21-28 are believed to be allowable for at least the reasons presented herein for allowance of claims 1, 15 and 16. Moreover, claims 21-28 recite different elements/limitations and recite different combinations of these elements/limitations than those recited in claims 1, 15 and 16. Applicants request the Office action comply with the MPEP and either allow a claim or provide a proper rejection for each and every combination of claim elements/limitations.

### **CONCLUSION**

In view of the above amendments and remarks, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

The Commissioner is hereby generally authorized under 37 C.F.R. § 1.136(a)(3) to treat this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 requiring an extension of time as incorporating a request therefor, and the Commissioner is hereby specifically authorized to charge Deposit Account No. 02-2666 for any fee that may be due in connection with such a request for an extension of time.

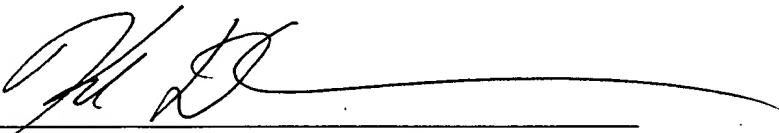
HOBBS ET AL.  
Application No. 08/992,222

The Commissioner is hereby authorized to charge payment of any fee due any under 37 C.F.R. §§ 1.16 and § 1.17 associated with this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 or credit any overpayment to Deposit Account No. 02-2666.

Respectfully submitted,  
**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN**

Date: September 3, 1999

By



Kirk D. Williams, Reg. No. 42,229  
One of the Attorneys for Applicants  
12400 Wilshire Blvd., 7<sup>th</sup> Floor  
Los Angeles, CA 90025-1026  
303-740-1980  
303-740-6962 (facsimile)